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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1857.0140002

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on _____

Signature _____

Typed or printed name Jason D. Eisenberg

Application Number

10/730,947

Filed

December 10, 2003

First Named Inventor

Justin L. Kreuzer

Art Unit

2872

Examiner

Lee A. Fineman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

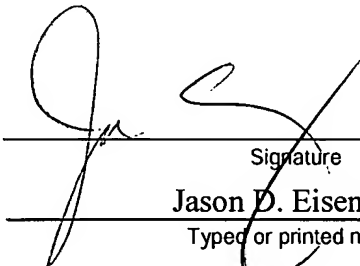
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 43,447



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12/15/06

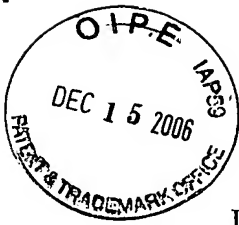
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Justin L. Kreuzer

Appl. No.: 10/730,947

Filed: December 10, 2003

For: **Optical Reduction System With
Control of Illumination
Polarization**

Confirmation No.: 6299

Art Unit: 2872

Examiner: Lee A. Fineman

Atty. Docket: 1857.0140002

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits the following Arguments in support of the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Claims 1, 4-10, and 12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over JP 06-215997 to Matsumoto ("Matsumoto") in view of U.S. Patent No. 5,593,606 to Owen et al. ("Owen"). Claim 2 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Matsumoto in view of Owen, and in further view of U.S. Patent No. 5,952,818 to Zhang et al. ("Zhang"). Claim 3 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Matsumoto in view of Owen, and in further view of U.S. Patent No. 4,342,517 to Johnson et al. ("Johnson").

Applicant's arguments in the Amendment and Reply under 37 C.F.R. § 1.111 filed on July 5, 2006 ("the 7/5/06 reply"), in response to the Office Action mailed April 6, 2006, were not properly considered or responded to in the final Office Action mailed September 18, 2006 ("the final Office Action"). Further, Applicant's arguments in the Amendment and Reply under 37 C.F.R. § 1.116 filed on November 16, 2006 ("the 11/16/06 AF reply"), in response to the final Office Action, were not properly considered or responded to in the Advisory Action mailed November 30, 2006 ("the Advisory Action"). The Examiner's response was legally deficient because the Examiner inappropriately applied at least Matsumoto, Owen, and *In re Van Geuns*,

988 F.2d 1181 (Fed. Cir. 1993). In particular, the Examiner has failed to properly construe the claimed features, and therefore has misapplied both the references and the law. The Examiner used this inappropriate rejection in an attempt to show that an axis recited in claim 1 was not recited as starting at a light source and passing through a reticle and a variable wave plate before passing through a first optical device.

In sum, the rejection of Matsumoto in view of Owen (and *In re Van Geuns*) failed to properly construe the claimed features, the applied references, and the law. Thus, for at least these reasons the Examiner has failed to establish a *prima facie* case of obviousness for the claimed invention, since all the claimed features must be taught or suggested by the prior art M.P.E.P. § 2143.03, citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974), which they are not.

The Examiner failed to properly construe the claimed features

The Examiner has failed to properly construe the claimed features. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness using the applied references.

Claim 1 recites “wherein the reticle is positioned along an axis of a light beam path between a source of the light beam and the first optical device.” This means “an axis of a light beam path” is “between a source of the light beam and the first optical device,” and that the “reticle is positioned along [the] axis.” This meaning of this claimed phrase is argued by Applicant’s in at least the 7/5/06 reply.¹

In contrast, the Examiner improperly interprets this claimed phrase to mean (see, e.g., page 6 of the Final Office action) “[the language] only requires that the reticle is positioned along the axis and that the reticle is between a source of the light beam and the first optical device and not that the light source must be along the axis as well.” The Examiner attempts to substantiate his allegations using *In re Van Geuns*. However, this case cannot be used to support the Examiner’s allegations in the instant application. This is because in *In re Van Geuns*, e.g., as discussed in M.P.E.P. §2145(VI), it was stated that, although the specification disclosed that the

¹ In the 11/16/06 AF reply, Applicant merely clarified the claim features in line with the arguments Applicant had been making in response to several Office Actions. The amendments in the 11/16/06 AF reply should have been entered because they did not raise any new issues or place a burden on the Examiner as the Examiner had already considered and responded to these features in the Examiner’s previous arguments. Also, these claim amendments placed the claims in better condition for allowance and/or appeal, and should have been entered for these reasons as well.

claimed invention may be used in a particular apparatus, the claims were not so limited. However, in contrast to this statement in *In re Van Geuns*, the pending instant claims recite features that do limit them to what Applicant is arguing, as just noted above. Thus, Applicant is not just relying on arguments directed to what is supported in the specification, but what is recited in the claims.

Therefore, because the Examiner has failed to properly construe the claimed features, the Examiner has failed to establish a *prima facie* case of obviousness over the applied references.

The Examiner has failed to establish a prima facie case of obviousness in view of proper claim construction

In view of the proper claim construction noted above, the Examiner has failed to establish a *prima facie* case of obviousness.

Claim 1 recites features that distinguish over the applied references. For example, claim 1 recites a reticle that is positioned along an axis of a light beam path, the axis being between a source of a light beam and a first optical device, and a variable wave plate is positioned along the axis next to the reticle and before the first optical device. For example, as seen in Figures 3-9 and related text in the instant specification, “an axis of a light beam path” can be defined as a straight line starting at a light source (e.g., 302, 402, 502, 602, 702, 802, or 902) and passing through a respective first optical system (e.g., 320, 420, LG1, LG4, or LG7), as recited in claim 1. This same axis passes through the reticle and variable wave plate between the light source and the first optical system.

The Examiner does not specifically discuss what he alleges in Matsumoto teaches or suggests the recited “axis” feature. Also, there is no teaching or suggestion in Matsumoto that meets the recited “axis” feature. In contrast to what is recited in claim 1, Matsumoto’s optical system includes a first axis between a light source 20 and a beam splitter 15 and a second axis between a reflection device 12 and a substrate 19, which second axis also passes through a reticle 14 and a quarter wave plate 16, but the second axis is perpendicular to the first axis.

Owen is not used by the Examiner to cure this deficiency in Matsumoto, nor does it cure this deficiency. Also, any use by the Examiner to apply piecemeal parts of Owen’s optical system to Matsumoto’s optical system to cure this deficiency would destroy the teaching in Matsumoto by making the optical system unsatisfactory for its intended purpose and/or change the optical

system's principle of operation. See M.P.E.P § 2143.01(V) and (VI). Therefore, Matsumoto and Owen cannot be used by the Examiner to form a *prima facie* case of obviousness.

None of the other applied references, Zhang and Johnson, are used to teach or suggest this feature in claim 1, nor do they teach or suggest this feature. Thus, these other applied references fail to cure the deficiencies of Matsumoto and Owen, and cannot be used by the Examiner to form a *prima facie* case of obviousness.

Therefore, none of the applied references, either alone or in an alleged obvious combination, teach or suggest a reticle that is positioned along an axis of a light beam path, the axis being between a source of a light beam and a first optical device, and a variable wave plate is positioned along the axis next to the reticle and before the first optical device, as recited in claim 1. Also, at least based on their dependency to claim 1, claims 2-10 and 12 should be found allowable over the applied references.

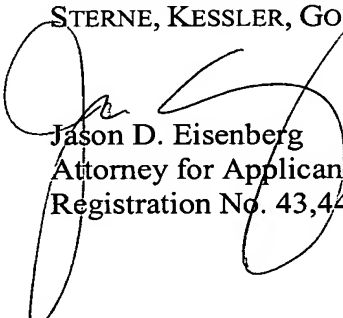
Conclusion

The Examiner has thus failed to establish a *prima facie* case of obviousness for at least the reasons the Examiner failed to properly construe the claimed features. Thus, the Examiner's reliance upon at least Matsumoto in view of Owen, and *In re Van Geuns*, in supporting an obviousness rejection for the pending claims is factually and legally unfounded.

Therefore, Applicant respectfully requests reconsideration and withdrawal of rejections under 35 U.S.C. § 103(a) for all claims in the pending application.

Respectfully submitted,

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